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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,188

10/31/2006

Holger School

DE 040077

5627

24737

7590

09/15/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

NIGH, JAMES D

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

09/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,188	<b>Applicant(s)</b> SCHOOL, HOLGER	
	<b>Examiner</b> JAMES D. NIGH	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3 May 2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to application filed on 22 September 2006.

Claims 1-12 are presented for examination on the merits.

#### ***Priority***

2. Receipt is acknowledged of papers submitted 22 March 2004 under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) was submitted on 3 May 2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

6. Claims 1, 8 and 9 recite a method but do not positively recite physical structure as performing the method, nor is a physical transformation occurring. In addition it has been determined that a recitation of technology within the preamble is merely a nominal recitation of technology (*Ex parte Langemyr*, 89 USPQ2d 1988 (Bd. Pat. App. & Int. 2008). See "Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility", issued 24 August 2009. Recitations such as "receiving... from a device" and "transmitting... to a device" are extra solution activity. The rejection may be overcome

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by positively reciting physical structure within the limitations, such as “transmitting, by a receiving device...”

7. Claims 2-7 are also rejected as being dependent upon claim 1.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (U.S. Patent PG Publication 2003/0097331, hereinafter referred to as Cohen) in view of Cooper et al. (U.S. Patent 5,689,560, hereinafter referred to as Cooper).**

10. As per claims 1, 8, 11 and 12

Cohen discloses setting up a private communication channel between said receiving device and said transmitting device (0079, 0082, 0087-0088, 0107, 0111)

Cohen discloses transmitting a payment container to said transmitting device using said private communication channel, said payment container comprising information authorizing the seller to receive the payment from the buyer's bank (0040, 0053, 0139, 0154, 0210)

Cohen does not explicitly disclose receiving said content from said transmitting device based on the arrival of said payment container at said transmitting device.

Cooper teaches the receipt of content (3:10-48, 4:56-5:30, 9:59-10:33, 12:66-13:44)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the systems for financial and electronic commerce of Cohen with the method for enabling trial period use of software products of Cooper for the purpose of allowing customers to access software products prior to making decisions on whether or not to purchase the software product.

11. As per claim 2

Cohen discloses wherein said payment container comprises authentication data of the buyer (0087-0088, 0118, 0268, 0292, 0294-0295, 0343, 0376), however this is non-functional descriptive material and therefore is not entitled to any patentable weight “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, “We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability” See *In re Lowry*, 32 F.3d 1579, 1583 [32 USPQ2d 1031] (Fed. Cir. 1994). *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008).

12. As per claim 3

Cohen discloses wherein the authentication data is biometric (0079, 0111, 0377); however this is non-functional descriptive material.

13. As per claim 4

Cohen discloses wherein the authentication data is a digital signature (0073, 0294, 0377) although this is non-functional descriptive material.

14. As per claim 5

Cohen discloses wherein the payment container comprises authorisation data to the buyer's bank authorising the bank to perform the payment, said authorisation data being encrypted by the receiving device, whereby only the bank is capable of reading the authorisation data generating a private communication line between the receiving device and the bank via the transmitting device (0079, 0087-0088, 0111, 0376-0377) however this is non-functional descriptive material.

15. As per claim 6

Cooper teaches receiving time restricted content transmitted from said transmitting device using said private communication channel said received time restricted content comprising a time restriction whereby said content is accessible on said receiving device in a predefined limited time period (2:28-64, 3:10-4:21, 12:4-25)

"before transmitting said payment container to said transmitting device" see MPEP § 2144.04 IV C. Changes in Sequence of Adding Ingredients, *Ex parte Rubin* , 128 USPQ 440 (Bd. App. 1959) as order of steps cannot be used to establish patentability; however as Cooper teaches a trial period (2:28-64, 3:10-4:21, 12:4-25) this is inherent to Cooper.

Cooper teaches receiving information from the transmitting device after transmitting said payment container, said information removing said time restriction from said content (9:1-38, 9:59-10:33, 20:32-21:3).

16. As per claims 7 and 10

Cohen discloses computer readable media capable of executing the method (0442-0449)

17. As per claim 9

Cohen discloses setting up a private communication channel between said receiving device and said transmitting device (0079, 0082, 0087-0088, 0107, 0111)

Cohen discloses receiving a payment container to said transmitting device using said private communication channel, said payment container comprising information authorizing the seller to receive the payment from the buyer's bank (0040, 0053, 0139, 0154, 0210)

Cooper teaches transmitting time restricted content transmitted from said transmitting device using said private communication channel said received time restricted content comprising a time restriction whereby said content is accessible on said receiving device in a predefined limited time period (2:28-64, 3:10-4:21, 12:4-25)

Cooper teaches transmitting information from the transmitting device after transmitting said payment container, said information removing said time restriction from said content (9:1-38, 9:59-10:33, 20:32-21:3).

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/  
Examiner, Art Unit 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685